

DETAILED ACTION

This action is responsive to communications: Appeal Brief filed in 1/15/07.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claims 1-18, and 20 are pending in this application. Claims 1 and 7 are independent claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18, and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. In re Angstadt, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976).

2164.01(a) Undue Experimentation Factors

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

The limitation regarding “single clicking of an input device to accept the displayed optimized arrangement and double clicking of the input device to cancel the display optimized arrangement” is not supported by the specification or the original claims.

(A) The breadth of the claims: The claim recites the limitation: “single clicking of an input device to accept and clicking of the input device twice to cancel the display optimized arrangement.” “Clicking the input device twice” can reasonable be interpreted as making two consecutive clicks within a second, making them within a hour, making them within a day or even making them within a week or more. Thus, the breadth of this limitation is unlimited.

(B) The nature of the invention: The invention relates to a method for providing, and an apparatus hosting, an improved Graphical User Interface that has little or nothing to do with the operation of the mouse, itself. Applicant’s specification does not provide any additional details for this limitation except for a literal restatement of the limitation in page 4 and page 5 (see

specification page 4 and 5: “if the user approves the new menu order, the optimization button is pressed one; if the user does not approve... the user presses the button twice). In fact the word click is cited only once in the entire specification; (Page 2 of specification “The user may then decide by clicking on the respective option icon to select on of the options.”) and the word mouse is cited only three times in the specification (see page 3, page 4 and page 5 of specification). As can be clearly seen, the invention is related to graphical user interface not a mouse. One of ordinary skill in the art would expect the mouse to operate in a conventional manner (as opposed to the manner claimed) and without further guidance would be at a loss as to how to make the mouse operate in the manner claimed.

(C) The state of the prior art: The prior art teaches exactly the opposite of what is taught here. Hong teaches a single click of an input device to cancel and double clicking of the input device (clicking twice within a fraction of second) to confirm. (column 5, lines 45-column 6, lines 15). This is the only known way for the mouse to operate, because other wise there would be confusion to the mouse operation.

(E) The level of predictability in the art: The art is predictable. Clicking is set up in the conventional manner as described by Hong (one click to cancel and double click to accept) because any other set up simply won't work. If the scenario claimed by appellant were implemented any acceptance would be canceled the next time a user clicked the mouse for any reason. For example, if user decide to follow applicant's implementation and try to click twice to cancel, a confusion would be created because the first click would indicate acceptance and the second click would only reaffirm that acceptance.

(F) The amount of direction provided by the inventor: There is no direction provided by the inventor. Applicant's specification only has a literal restatement of the limitation in page 4 and page 5. (see specification page 4 and 5: "if the user approves the new menu order, the optimization button is pressed one; if the user does not approve... the user presses the button twice).

(G) The existence of working examples: There are no working examples set forth in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Hochstedler U.S. Patent 6,707,476 in view of Hoffberg U.S. Patent 6,400,996 in view of Sakata US Patent 6,593,938, further in view of Hong US Patent 7,079,166.

As per claim 1, Hochstedler teaches a method of customizing a graphical user interface for a computer controlled system having at least one selectable parameter, comprising the steps of:

devising an optimized arrangement of the parameter selection which matches a pattern of selection; (see Hochstedler, column 5, lines 37-column 6, lines 34)

actuating an input mechanism such that a first actuation of the input device accepts the displayed optimized arrangement and a second actuation of the input device cancels the displayed optimized arrangement. (see Hochstedler, column 8, lines 43-55)

However Hochstedler fails to teach monitoring the selection of the at least one selectable parameter by a user, and determining any pattern of selection.

Hoffberg teaches monitoring the selection of the at least one selectable parameter by a user, and determining any pattern of selection. (see Hoffberg, abstract, lines 1-21; col. 50, line 53-col. 51, line 14; col. 116, lines 50-64)

It would have been obvious to an artisan at the time of the invention to include Hoffberg's teaching with the method of Hochstedler in order provide users with an adaptive user interface that changes in response to users' past history.

However, both Hochstedler and Hoffberg fail to teach displaying the optimized arrangement.

Sakata teaches allowing user to preview an optimized arrangement. (column 16, lines 38-column 17, lines 5)

It would have been obvious to an artisan at the time of the invention to include Sakata's teaching with the method of Hochstedler and Hoffberg in order to provide a preview of the optimized arrangement.

However Hochstedler, Hoffberg, and Sakata fail to teach single clicking of an input device to accept and double clicking to cancel.

Hong teaches single clicking of an input device to accept and double clicking to cancel. (column 5, lines 45-column 6, lines 15)

It would have been obvious to an artisan at the time of the invention to include Hong's teaching with the method of Hochstedler, Hoffberg, and Sakata in order to allow a user to move easily through different screens of the interface.

As per claim 2 Hochstedler, Hoffberg, Sakata, and Hong teach a method according to Claim 1. Hochstedler further teaches the parameters are displayed as a menu and the order of the parameters in the menu is varied. (see Hochstedler, column 5, lines 37-column 6, lines 34)

As per claim 3, Hochstedler, Hoffberg, Sakata, and Hong teach a method according to Claim 1. Hoffberg further teaches the selectable parameters are channels of a multi-channel television system. (see Hoffberg, column 116, lines 37-49, column 50, lines 53-62)

It would have been obvious to an artisan at the time of the invention to include Hoffberg's teaching with the method of Hochstedler in order provide users with an adaptive television navigational interface.

As per claims 4, 5 and 6, Hochstedler, Hoffberg, Sakata, and Hong teach a method according to claim 1. Hoffberg further teaches the method in which the selectable parameters are processing parameters of an optical processing system that is an x-ray image processing or recording system (medical device interfaces) (see Hoffberg, col. 131, line 49-col. 132, line 17).

As per claim 7, Hochstedler teaches a computer controlled system having a customizable graphical user interface by which a plurality of parameters can be selected comprising:

display means to display the parameters;

selection means to select the parameters; (see Hochstedler, column 5, lines 37-column 6, lines 34)

an input device arranged so that a first actuation of the input device accepts the optimized arrangement and a second actuation of the input device cancels the optimized arrangement. (see Hochstedler, column 8, lines 43-55)

However Hochstedler fails to teach monitoring means to monitor the selection of parameters and to devise an optimized arrangement of the parameter selection.

Hoffberg teaches monitoring means to monitor the selection of parameters and to devise an optimized arrangement of the parameter selection. (see Hoffberg, abstract, lines 1-21; col. 50, line 53-col. 51, line 14; col. 116, lines 50-64)

It would have been obvious to an artisan at the time of the invention to include Hoffberg's teaching with the method of Hochstedler in order provide users with an adaptive user interface that changes in response to users' past history.

However, both Hochstedler and Hoffberg fail to teach displaying the optimized arrangement.

Sakata teaches allowing user to previewing an optimized arrangement. (column 16, lines 38-column 17, lines 5)

It would have been obvious to an artisan at the time of the invention to include Sakata's teaching with the method of Hochstedler and Hoffberg in order to provide a preview of the optimized arrangement.

However Hochstedler, Hoffberg, and Sakata fail to teach single clicking of an input device to accept and double clicking to cancel.

Hong teaches single clicking of an input device to accept and double clicking to cancel.
(column 5, lines 45-column 6, lines 15)

It would have been obvious to an artisan at the time of the invention to include Hong's teaching with the method of Hochstedler, Hoffberg, and Sakata in order to allow a user to move easily through different screens of the interface.

As per claim 8, Hochstedler, Hoffberg, Sakata, and Hong teach a system according to claim 7. Hochstedler further teaches the input device is a single button control. (see Hochstedler, column 1, lines 10-15; Touch pad is a single button control.)

As per claim 9, Hochstedler, Hoffberg, Sakata, and Hong teach a method according to Claim 1. Hochstedler further teaches in which the selectable parameters are displayed as a menu in the optimized arrangement and the first actuation of the input device accepts the optimized arrangement and the second activation of the input device cancels the optimized arrangement. (see Hochstedler, column 8, lines 43-55)

As per claim 10, Hochstedler, Hoffberg, Sakata, and Hong teach a method according to Claim 9. Hochstedler further teaches the selectable parameters that are displayed on the menu are arranged in accordance with user preferences. (see Hochstedler, column 7, lines 47-60)

As per claim 11, Hochstedler, Hoffberg, Sakata, and Hong teach a method according to Claim 9. Hochstedler further teaches the selectable parameters that are displayed on the menu are arranged according to recent usage.

As per claims 12-14, they are of the same scope as claims 9-11 and are rejected respectively. Supra.

As per claim 15, it is of the same scope as claim 3. Supra

As per claims 16-18 are of the same scope as claims 4-6, and are rejected respectively. Supra.

As per claim 20, it is of the same scope as claim 8. Supra.

Response To Argument

Applicant's arguments with respect to claims 1-18, and 20 have been considered but are deemed to be moot in view of the new grounds of rejection.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peng Ke whose telephone number is (571) 272-4062. The examiner can normally be reached on M-Th and Alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L. Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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